Attorney Docket RSW920010194US1

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re application of John R. Hind, et al.   May 9, 2006

Serial Nbr: 09/973,883

Filed: October 10, 2001

For: Adaptive Indexing Technique for Use with Electronic Objects

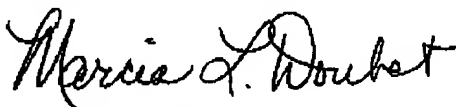Art Unit: 2166   Examiner: Isaac M. Woo

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA   22313-1450

Sir:

Applicants hereby request review of the Final Rejection in the Office Action mailed

February 13, 2006 in the above-identified Application. No amendments are being filed with this

request. This request is being filed with a Notice of Appeal. Review is requested for the reasons

stated on the attached sheets.

Respectfully submitted,

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GROUNDS OF REJECTION PRESENTED FOR REVIEW

The **first ground of rejection** presented for review is a rejection of Claims 1 and 18 - 19

under 35 U.S.C. §112, second paragraph, as being indefinite, according to the Office Action

mailed on February 13, 2006 (hereinafter, "the Office Action").

The **second ground of rejection** presented for review is a rejection of Claims 1 - 5, 7 - 8,

and 10 - 19 under 35 U.S.C. §102(e) as being anticipated by U. S. Patent 6,792,430 to Kenyon et

al. (hereinafter, "Kenyon"), according to the Office Action.

ARGUMENT

For expediency only, for the **Second Ground of Rejection**, Applicants will discuss their

independent Claims 1, 18, and 19 with regard to Claim 1. Applicants reserve the right to argue

additional grounds, and in particular to explicitly argue separate patentability of the dependent

claims, if this Petition is denied.

With regard to the **First Ground of Rejection**, Applicants respectfully submit that

Claims 1 and 18 - 19 are not indefinite (and Applicants note that the term "user-defined

organizing criteria" has been omitted when presenting the claim language of these claims in

Paragraph 3, lines 8 - 10 of the Office Action). The text of record for Claim 1 specifies

(emphasis added):

> A computer-implemented method for indicating criteria for organizing
> electronic objects, comprising steps of:
>   detecting, by a user input monitor, that a user has swiped across an
> element of a rendered representation of an electronic object;
>   comparing a manner in which the swiping was performed, responsive to
> the detecting, to previously-defined settings that specify what manner of swiping

indicates an identification of dynamically-identified, user-defined organizing criteria; and

     storing, if the comparing step determines that the manner in which the swiping was performed is consistent with the specified settings, the swiped-across element in a repository of criteria, from which the stored element can subsequently be selected for inclusion in a pattern to be matched against electronic objects for programmatically organizing the electronic objects.

Suppose, for example, that the "user has swiped across an element of a rendered representation" (where this "element" might be, for example, a portion of a displayed photo image) by passing the tip of his finger across the element 3 times within a 2-second time period. In this scenario, "a manner in which the [detected] swiping was performed" may comprise (i) swiping 3 times; (ii) swiping using the tip of his finger; and (iii) all swiping occurring within a 2-second time period. Further suppose that "previously-defined settings" exist which specify that a swiping must comprise (i) swiping 2 or more times (ii) within a 1-second time period, and if this happens, then the swiping can be considered as "indicat[ing] an identification of dynamically-identified, user-defined organizing criteria". Accordingly, in this example scenario, the comparing step compares the "manner in which the swiping was performed" (for ease of reference hereinafter, "the detected manner of swiping") to the "previously-defined settings that specify what manner of swiping indicates ..." (for ease of reference hereinafter, "the specified manner of swiping") — in other words, the swiping 3 times within a 2-second time period with a finger tip is compared to swiping 2 or more times within a 1-second time period. In this example, the detected manner of swiping is consistent with the specified manner of swiping, and thus the storing step will "stor[e] ... the swiped-across element in a repository of criteria ...".

Accordingly, it can be seen that independent Claims 1, 18, and 19 are not indefinite.

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With regard to the **Second Ground of Rejection**, Applicants respectfully submit that a *prima facie* case of anticipation under 35 U.S.C. §102 has not been made out as to independent Claim 1. Kenyon fails to teach or suggest at least the following recitations thereof: (1) detecting, by a user input monitor, that a user has swiped across an element of a rendered representation of an electronic object; (2) previously-defined settings that specify what manner of swiping indicates an identification of dynamically-identified, user-defined organizing criteria; and (3) comparing a manner in which the swiping was performed ... to [these] previously-defined settings.

With regard to Claim 1, Paragraph 5 of the Office Action cites passages in col. 4 of Kenyon. However, Applicants respectfully submit that none of the cited passages teaches the above-noted recitations. Selecting a URL, for example, fails to teach "comparing a manner in which the swiping was performed" and checking if the user-selected URL is in an overlay fails to teach "... to previously-defined settings that specify what manner of swiping ...", in contradiction to what is stated in Paragraph 5, lines 4 - 8 of the Office Action.

Kenyon also fails to teach limitations of a number of Applicants' dependent claims. For example, dependent Claim 3 specifies "repeatedly swiping across" (Claim 3, line 2). This claim is discussed on Page 4 of the Office Action, where col. 5, lines 14 - 37 of Kenyon are cited. Applicants respectfully submit that this cited text has no discussion, nor any suggestion, of "repeatedly" swiping across anything.

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Dependent Claims 11 - 13 specify "swip[ed] across ... at least twice" (Claim 11, lines 2 -

3). These claims are discussed on Pages 5 - 6 of the Office Action, where Fig. 1 and col. 4, lines

54 - 65 of Kenyon are cited for each claim. Applicants respectfully submit that this cited figure

and text have no discussion, nor any suggestion, of swiping across anything "at least twice".

Dependent Claim 15 specifies "passing his or her eyes repeatedly over ..." (Claim 15, line

3), and dependent Claim 16 specifies "swiped across multiple times" (Claim 16, line 2). These

claims are discussed on Page 6 of the Office Action, where col. 4, lines 12 - 44 of Kenyon are

cited for each claim. Applicants respectfully submit that this cited text has no discussion, nor

any suggestion, of "passing eyes repeatedly" over anything or swiping across anything "multiple

times".

Section 706.02 of the MPEP, "Rejection on Prior Art", states in Section IV, "Distinction

Between 35 U.S.C. 102 and 103", the requirements for establishing a *prima facie* case of

anticipation under 35 U.S.C. 102, noting that "... for anticipation under 35 U.S.C. 102, the

reference must teach every aspect of the claimed invention either explicitly or impliedly"

(emphasis added). This requirement is also stated in MPEP §2131, "Anticipation -- Application

of 35 U.S.C. 102(a), (b), and (e)", which states (in its final paragraph) "A claim is anticipated

only if each and every element as set forth in the claim is found, either expressly or inherently

described, in a single prior art reference", quoting *Verdegaal Bros. v. Union Oil Co. of

California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), emphasis added.

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Because Kenyon fails to teach or suggest <u>each and every element as set forth in</u> <u>Applicants' independent Claims 1, 18, and 19,</u> as demonstrated above, Kenyon does <u>not</u> <u>anticipate</u> Applicants' independent Claims 1, 18, and 19. Furthermore, Kenyon does <u>not</u> <u>anticipate</u> Applicants' dependent Claims 3, 11 - 13, and 15, because -- as demonstrated above -- Kenyon <u>fails to teach or suggest</u> each and every element as set forth in these dependent claims.

Because the Office Action fails to make out a *prima facie* case of anticipation with regard to independent Claims 1, 18, and 19, in violation of the above-quoted MPEP §706.02 and §2131, those independent claims are deemed patentable. All remaining dependent claims are therefore deemed patentable by virtue of (at least) the patentability of the independent claims from which they depend.

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